# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/603,303 | 06/23/2000 | Scott Lorenz | 5053-36000 | 1772 |

| 7590 | 05/18/2006 |
|---|---|

ERIC B. MEYERTONS, ESQ.
CONLEY, ROSE & TAYON, P.C.
P.O. BOX 398
AUSTIN, TX 78767-0398

| EXAMINER |
|---|
| BLECK, CAROLYN M |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3626 | |

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

# MAILED

MAY 1 8 2006

# GROUP 3600

## BEFORE THE BOARD OF PATENT APPEALS
## AND INTERFERENCES

Application Number: 09/603,303
Filing Date: June 23, 2000
Appellant(s): LORENZ, SCOTT

---

Eric B. Meyertons
For Appellant

## EXAMINER'S ANSWER

This is in response to the appeal brief filed 1 March 2006 appealing from the

Office action mailed 12 November 2004.

### (1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

### (2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

### (3) Status of Claims

The statement of the status of claims contained in the brief is correct.

### (4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

### (5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

### (6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

## (7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

## (8) Evidence Relied Upon

| | | |
|---|---|---|
| 5,950,169 | Borghesi et al. | 9-1999 |
| 6,505,176 | DeFrancesco, Jr. et al. | 1-2003 |
| US 2002/0035488 A1 | Aquila et al. | 3-2002 |

## (9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

### *Claim Rejections - 35 USC § 103*

1.     The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.     Claims 1-2, 5-11, 13-18, and 20-22 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Borghesi et al. (5,950,169) in view of DeFrancesco, Jr. et al.

(6,505,176).

(A)  As per claim 1, Borghesi discloses a system for managing insurance claim

processing comprising:

(a)  a communication server for insurance claim management comprising a

processor coupled to memory, wherein the memory is embodied as a mass storage

device and storing a program constructed using known software tools and languages,

wherein the program is used for (col. 5 line 50 to col. 6 line 13, col. 7 line 54  to col. 8

line 2, col. 10 lines 50-56, and col. 20 lines 33-50):

transmitting, from a remote computer, a predetermined amount of data related to

calculating a total loss valuation to the server, wherein the predetermined amount of

data is input by a user through a user interface, wherein the total loss valuation is then

sent back to the remote computer (Figure 1, 7, col. 21 lines 29-35 and col. 23 lines 17-

34);

(b)  at least one remote computer terminal comprising a processor coupled to

memory, wherein the memory is embodied as a mass storage device and storing a

program constructed using known software tools and languages, wherein the program

is used for (col. 5 line 50 to col. 6 line 13, col. 7 line 54  to col. 8 line 2, col. 10 lines 50-

56, and col. 20 lines 33-50):

inputting and outputting data pertaining to an insurance claim through a graphical

user interface (col. 23 lines 17-34); and

sending an insurance claim data file over a network to the communication server,

wherein the data file contains data on the insured, data on a claim, and data on

satisfying a claim (col. 20 line 55 to col. 21 line 17 and col. 22 lines 19-40).

Borghesi fails to expressly disclose a sequence of insurance claim processing steps executable to complete an insurance claim processing task, wherein the number of insurance claim processing steps and/or the sequence of execution of the insurance claims processing steps are established dynamically in real time and wherein a second set of program instructions comprises a sequence of steps established dynamically in real time.

DeFrancesco discloses a method for dynamically managing workflow for an automated application system in response to functions executed by a user or by the automated application system comprising the step of processing a workflow for an application by identifying an executed function, wherein said executed function can be executed by the user or by the automated application system, finding a set of potentially affected workflow process steps comprising all workflow process steps associated with said executed function, calculating the status of each workflow process step in said set of potentially affected workflow process steps, dynamically determining, in response to said identifying steps, said finding step, and said calculating step, a next step for each said workflow process step (col. 16 line 58 to col. 17 line 28, col. 18 lines 58-60). Further, DeFrancesco discloses an example of the "dynamically determining steps" comprising saving information and then updating several database elements, wherein the two database elements include "primary income" and "secondary income". An associated rule element "total income" is derived from the database elements of primary and secondary income, wherein the rule element is derived as follows: "total income=primary income + secondary income". Next, a test associated with the total

income rule element is created called the "verify" test, wherein the verify test is true if

the total income is greater than $20,000, wherein a process step exists that requires an

Appellant's income to be verified only if the verify test is true, and if the verify test is

false, the process step is skipped. Therefore, using this example, the user action of

inputting and saving an Appellant's income to the database, causes the verify test to be

evaluated. If the test is true, the process step becomes an active step in the workflow.

If the test is false, the process step is skipped. The appropriate workgroup queues are

updated to include the process step only if the verify test is true (col. 6 line 65 to col. 7

line 60). Further, DeFrancesco discloses that the steps may be executed in any order

and the steps are executed using a dynamic module of a computer system having

instructions loaded upon it and connected to workstations having instructions over a

network (col. 4 line 61 to col. 5 line 23, col. 5 lines 46-65, col. 8 line 22 to col. 9 line 23,

col. 9 lines 52-64, col. 15 line 30 to col. 16 line 47).

At the time the invention was made, it would have been obvious to one of

ordinary skill in the art to combine the teachings of DeFrancesco within the method of

Borghesi with the motivation of allowing steps within a process and the order in which

these steps are processed to vary (DeFrancesco; col. 2 lines 3-12), thus reducing the

cycle time for development and testing of software and reducing the costs in developing

software (DeFrancesco; col. 2 lines 12-24).


(B) As per claim 2, Borghesi discloses the insurance claim data file comprising data

gathered concerning the extent of damage or injury suffered by the insured, insurance

claim settlement information including data on satisfying a claim such as estimates and a total loss calculation for a claim (col. 2 lines 50-59, col. 5 lines 5-15, col. 22 lines 54-63, and col. 23 lines 4-16).

(C) As per claim 5, 11, and 18, DeFrancesco discloses a network such as the Internet (col. 4 lines 40-60).

Borghesi and DeFrancesco do not expressly disclose the Internet protocols being HTTP. However, when communicating information from a server to a browser over the Internet, the protocol almost universally used is HTTP, and the skilled artisan would have found it an obvious modification to include communicating using the Internet and HTTP within the system taught by Borghesi and DeFrancesco with the motivation of increasing the ease of access to information and calculations from a remote computer (Borghesi; Fig. 3 and col. 10 lines 28-45) including reducing the time to access information.

(D) As per claim 6, Borghesi discloses the server and remote computer terminals format and send data over a network using TCP/IP (Fig. 2 and col. 11 lines 44-52).

(E) As per claim 7, Borghesi discloses at least one remote computer and a network connecting the computers to a server (Fig. 2 and col. 20 lines 33-50). The remainder of claim 7 repeats the same limitations of claim 1, specifically with regards to the steps

performed using the apparatus of claims 1, and therefore claim 7 is rejected for the same reasons given above for claim 1, and incorporated herein.

(F) As per claims 8, 15, and 22, Borghesi discloses an insurance claim data file comprising data gathered concerning the extent of damage or injury suffered by the insured, insurance claim settlement information including data on satisfying a claim such as estimates and  a total loss calculation for a claim (col. 2 lines 50-59, col. 5 lines 5-15, col. 22 lines 54-63, and col. 23 lines 4-16).  Borghesi also includes repairing the damaged object (col. 15 lines 64 to col. 16 lines 22).  Borghesi fails to expressly disclose the one or more treatments of bodily injuries.  However, it is respectfully considered that repairing a damaged object is considered a form of treatment to fix the damaged object.  The skilled artisan would have found it an obvious modification to include treatments of bodily injury within the system taught collectively by Borghesi and DeFrancesco with the motivation of efficiently managing an insurance claim workflow by performing, evaluating, and documenting all tasks when processing a claim (Borghesi; col. 2 lines 20-30).

(G) Method claims 9-10 and 13-14 repeat the subject matter of system claims 1-2 and 6, respectively, as a series of steps rather than as a set of apparatus elements.  As the underlying apparatus elements of claims 1-2 and 6 have been shown to be fully disclosed by the collective teachings of Borghesi and DeFrancesco in the above rejections of claims 1-2 and 6, it is readily apparent that the method disclosed

collectively by Borghesi and DeFrancesco includes the steps performed by the

apparatus. As such, these limitations are rejected for the same reasons given above for

method claims 1-2 and 6, and incorporated herein.


(H) Claims 16-17 and 20-21 repeat the subject matter of system claims 1-2 and 6,

respectively, as a carrier medium comprising computer instructions to carry out the

functionality of the system from method claims 1-2 and 6. As the underlying apparatus

elements of claims 1-2 and 6 have been shown to be fully disclosed by the collective

teachings of Borghesi and DeFrancesco in the above rejections of claims 1-2 and 6, it is

readily apparent that the programs embodied in a mass storage device or memory of a

computer (Borghesi; col. 5 line 50 to col. 6 line 13, col. 7 line 54 to col. 8 line 2, col. 10

lines 50-56, and col. 20 lines 33-50) disclosed by the collective teachings of Borghesi

and DeFrancesco provides the means to carry out the functions of the system. As

such, these limitations are rejected for the same reasons given above for method claims

1-2 and 6, and incorporated herein.


3.      Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Borghesi et al. (5,950,169) and DeFrancesco, Jr. et al. (6,505,176) as applied to claim

1, and further in view of Aquila et al. (US 2002/0035488 A1).


(A) As per claim 3, DeFrancesco discloses a rules module comprising a plurality of rule

elements, each of said rule elements associated with one or more of the database

elements, and each of said rule elements associated with one or more tests (col. 18

lines 32-42).

Borghesi and DeFrancesco fail to expressly disclose a rules engine and web

browser.

Aquila discloses utilizing business rules and a rules engine in a system for

insurance claims processing (Abstract; par. 129) and client software being a web

browser (par. 91).

At the time the invention was made, it would have been obvious to one of

ordinary skill in the art to combine the features of Aquila within the method taught

collectively by Borghesi and DeFrancesco with the motivation of increasing the flexibility

of an insurance claim capture system by not forcing claimants to fill out standardized

questions in standardized formats that often do not fit their needs (Aquila; par. 8).


(B)  As per claim 4, Aquila discloses capturing first notice of loss(FNOL) at a first notice

of loss system on the server through the consumer using client software, wherein the

FNOL validates the insurance policy under which the claim is being asserted, presents

the user with tailored questions, where the presentation format varies depending on the

type of user, wherein questions subsequent to certain gateway questions presented to

the user vary according to the user's answers to gateway questions, wherein the user

then fills out and submits answers to the questions with which he is presented, wherein

the FNOL determines if the submitted questionnaire is complete and the answers

submitted valid, and creates a new claim record for that claim, wherein the claim data

captured can be transmitted to and stored in the e-claim database or insurance carrier

system (Fig. 1-4, par. 91, 100-102, 111). Aquila also discloses the client software being

a web browser wherein responses from the server are built in XML and HTML (par. 97

and 91). Viewing data in a web browser using XML and HTML is considered to be a

form of Appellant's "web page".

The motivation for combining Aquila within Borghesi and DeFrancesco is given

above in claim 3, and incorporated herein.


## (10) Response to Argument


## First Ground of rejection

## Claim 1

In response to Appellant's argument that the cited prior art fails to disclose the

features of claim 1, the Examiner respectfully disagrees. Appellant argues that

Borghesi fails to teach or suggest an insurance claim processing server to estimate a

value of an insurance claim as a function of insurance claim assessment data.

Borghesi teaches a step of building an insurance datafile comprising transmitting a

predetermined amount of data related to calculating a vehicle total loss valuation to the

server, receiving the total loss valuation at the remote computer, and appending the

total loss valuation to the datafile (col. 21 lines 29-35). The Examiner respectfully

submits that the remote computer transmits data related to calculating a vehicle total

loss valuation to the server, and the remote computer then receives a total loss

valuation. In order to receive the total loss valuation at the remote computer, it would

appear that the server would have to perform a calculation of the total loss valuation

prior to sending the data to the remote computer. Further, it is noted that this server

can be a communications server dedicated to insurance claim management (Fig. 2, col.

5 line 51 to col. 6 line 5). Thus, the Examiner respectfully submits that Borghesi

teaches the feature of an insurance claim processing server to estimate a value of an

insurance claim as a function of insurance claim assessment data.

In response to Appellant's argument that there is no motivation to combine

Borghesi and DeFrancesco because Borghesi relates to insurance claim management

software and DeFrancesco relates to a credit application system, the examiner

recognizes that obviousness can only be established by combining or modifying the

teachings of the prior art to produce the claimed invention where there is some

teaching, suggestion, or motivation to do so found either in the references themselves

or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*,

837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21

USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner has provided a motivation

from within the references themselves. For example, the Examiner noted that the

motivation for combining DeFrancesco within Borghesi was to allow steps within a

process and the order in which these steps are processed to vary (DeFrancesco; col. 2

lines 3-12), thus reducing the cycle time for development and testing of software and

reducing the costs in developing software (DeFrancesco; col. 2 lines 12-24).

In addition, it has been held that a prior art reference must either be in the field of

Appellant's endeavor or, if not, then be reasonably pertinent to the particular problem

with which the Appellant was concerned, in order to be relied upon as a basis for

rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443

(Fed. Cir. 1992). In this case, the Examiner relied on the DeFrancesco reference to

teach dynamically establishing steps in real time, which is reasonably pertinent to the

particular problem Appellant is concerned with.


## Claim 2

In response to Appellant's argument that Borghesi fails to teach "an insurance

claim comprising a bodily injury claim, and wherein the estimate of the value of the

insurance claim comprises an estimate of bodily injury general damages," the Examiner

respectfully submits that Borghesi teaches an insurance claim comprising the extent of

damage or injury suffered by the insured (col. 2 lines 50-59, col. 22 lines 54-63), and

further valuing the loss of the insurance claim by the server as discussed in the

arguments related to claim 1 (col. 2 lines 50-59, col. 5 lines 5-15, col. 22 lines 54-63,

and col. 23 lines 4-16; see also col. 21 lines 29-35). Thus, the Examiner respectfully

submits that Borghesi teaches the features of claim 2.


## Claim 8

In response to Appellant's arguments that neither Borghesi or DeFrancesco

disclose, teach, or suggest "one or more treatments of bodily injuries," the Examiner

respectfully submits that Borghesi discloses an insurance claim data file comprising

data gathered concerning the extent of damage or injury suffered by the insured,

insurance claim settlement information including data on satisfying a claim such as

estimates and a total loss calculation for a claim (col. 2 lines 50-59, col. 5 lines 5-15,

col. 22 lines 54-63, and col. 23 lines 4-16). Further, Borghesi also includes repairing the

damaged object (col. 15 lines 64 to col. 16 lines 22). While Borghesi fails to expressly

disclose the one or more treatments of bodily injuries, it is respectfully submitted that

storing a datafile, data pertaining to repairing a damaged object is considered to be a

form of data pertaining to treatment to fix the damaged object (i.e., data pertaining to

treatment of bodily injuries of a person). Thus, the Examiner respectfully submits that

Borghesi teaches the features of claim 8.


## Claims 9, 14-16, and 21-22

Appellant's arguments related to claims 9, 14-16, and 21-22 rely upon or rehash the

issues addressed above, and are therefore moot in view of the responses given in the

discussion of claims 1, 2, and 8 above, and incorporated herein.


## Second Ground of Rejection

## Claim 3

In response to Appellant's argument that Aquila does not appear to teach the use

of business rules and a rules engine for estimating a value of an insurance claim, the

Examiner respectfully submits that the Examiner relied on Borghesi for teaching a

server for estimating the value of an insurance claim (col. 5 line 50 to col. 6 line 13, col.

7 line 54 to col. 8 line 2, col. 10 lines 50-56, and col. 20 lines 33-50). Borghesi and

DeFrancesco failed to disclose a rules engine, thus the Examiner relied on Aquila for

teaching this feature (see Abstract; par. 129). Thus, the Examiner respectfully submits

that the combination of Borghesi, DeFrancesco, and Aquila teach the features of claim

3.


### (11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Carolyn Bleck
Patent Examiner
Art Unit 3626


*C/B*
cb
May 16, 2006

Conferees
*JT*  JOSEPH THOMAS
Supervisory Patent Examiner
Tech Center 3600

Hyung (Sam) Sough
Supervisory Patent Examiner
Tech Center 3600

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER

Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C.
P.O. Box 398
Austin, TX 78767-0398